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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/418,932	10/15/1999	TAKAMOTO IMATAKI	0941.63354	9496

24978 7590 04/09/2003

GREER, BURNS & CRAIN
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CHICAGO, IL 60606

EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 04/09/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

PR2

Office Action Summary	Application No. 09/418,932	Applicant(s) IMATAKI, TAKAMOTO	
	Examiner William L. Bashore	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3, 6</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: original application filed 10/15/1999, with foreign priority filing date of 10/20/1998. IDS filed 10/30/2000 (paper 3), and 9/23/2002 (paper 6).
2. Claims 1-10 are pending. Claims 1, 8 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halliday et al. (hereinafter Halliday), U.S. Patent No. 5,880,740 issued March 9, 1999 in view of Mellgren, III et al. (hereinafter Mellgren), U.S. Patent No. 6,085,126 issued July 2000.

In regard to independent claim 1, Halliday teaches a workstation, which typically includes a memory (Halliday column 7 lines 5-17, Figure 10; compare with claim 1 "*a memory*").

Halliday teaches control structures downloaded as a file for creation/manipulation of a composite image on a workstation, images are created in accordance with image identifiers as defined in control blocks within said file, the creation of said images can be accomplished via a downloaded program (Halliday column 4 lines 40-59, column 5 lines 17-27, column 8 lines 29-34, column 9 lines 25-26, also Abstract, Figures 8, 9; compare with claim 1 "*display control means for generating a plurality of control*").

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blocks based on downloaded image information and program, said control blocks developing images in said memory based on the image information”).

Halliday teaches display of images and of possible alternative images as defined by a downloaded file as explained above (Halliday column 6 lines 7-11, Figures 1-6, Figure 10 items 121, 137; compare with claim 1 “*display means for displaying an image developed in said memory... ”*).

Halliday teaches an embodiment comprising creation of a greeting card, as well as a digital postcard (Halliday column 3 lines 6-12, Figures 1-6, column 9 lines 55-57). Halliday also teaches said embodiment in the form of a display kiosk (Halliday column 7 lines 23-29). Halliday does not specifically teach said greeting cards/postcards, and kiosk as selections corresponding to a business selected from another displayed image. However, Mellgren teaches a method of customizing imprintable media (i.e. calling cards, etc.) via a commercial kiosk available to consumers (Mellgren column 3 lines 45-51, 60-65). Mellgren teaches a user selecting a type of product (i.e. a list of business related products – stamps, calling cards, etc.) (Mellgren Figure 7), the following screen images are dependent upon user selection of an initial image from Figure 7 (Mellgren Figures 8-11, also column 6 lines 37-52; compare with claim 1 “*...and corresponding to a business which is selected from another image which is being displayed.*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Mellgren to Halliday’s file embodiment and kiosk, providing Halliday the benefit of offering additional material (i.e. business related material) to consumers in a commercial type kiosk environment (see also Mellgren Figures 21-22).

In regard to dependent claim 2, claim 2 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Halliday teaches use of a separate Netscape plug-in, as well as a downloadable Java applet for displaying and manipulating images of Halliday’s invention (Halliday column 9 lines 7-26).

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In regard to dependent claim 3, Halliday teaches control IDs identifying images to be displayed, as well as alternate images which can be displayed, or not displayed, depending upon user selection (Halliday Figure 8, 9, column 5 lines 13-28, column 6 lines 7-20).

In regard to dependent claim 6, Halliday teaches creation of a composite (i.e. compound) image, which involves sharing of image information (i.e. boundary information) between record identifiers (Halliday Figures 8-9, column 3 lines 6-13, column 4 lines 43-50, also Abstract).

In regard to dependent claim 7, Halliday teaches use of servers for downloading image information and programs (Halliday Figure 10 items 108, 110, 155, 157).

In regard to independent claim 8, claim 8 reflects the computer-readable medium for storing computer executable instructions used to implement the methods of the apparatus as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 9, 10, claims 9, 10 reflect the computer-readable medium for storing computer executable instructions used to implement the methods of the apparatus as claimed in claims 2, 6, respectively, and are rejected along the same rationale.

5. **Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halliday and Mellgren as applied to claim 1, above, and further in view of Bretschneider et al. (hereinafter Bretschneider), U.S. Patent No. 6,128,629 issued October 2000.**

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In regard to dependent claims 4-5, Halliday does not specifically teach timing regarding development and deletion of images. However, Bretschneider teaches a downloadable slide show program with images, said program automatically launched to a viewer which automatically displays a predetermined sequence of images for a predetermined amount of time (images are created and deleted according to a predetermined time) (Bretschneider Abstract, also column 5 lines 54-57; compare with claims 4-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Bretschneider to Halliday's card creation system with kiosk, providing Halliday the benefit of providing timed and periodic demonstrations of its offerings to prospective users.

Conclusion

6. **Prior art made of record and not relied upon is considered pertinent to disclosure.**

Cordell et al.	U.S. Patent No. 5,778,372	issued	07-1998
Barraclough et al.	U.S. Patent No. 6,301,607	issued	10-2001

Balasubramanian, V. et al., A large3-scale hypermedia application using document management and Web technologies, ACM Conference on Hypertext and Hypermedia, 1997, pages 134-145.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239 (for formal communications intended for entry)

or:

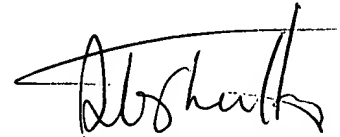
(703) 746-7240 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).

William L. Bashore
April 2, 2003



STEPHEN S. HONG
PRIMARY EXAMINER